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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,909	04/13/2004	Andrew J. Nelson	1878.001US1	3568
21186	7590	09/27/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/822,909	<b>Applicant(s)</b> NELSON ET AL.	
	<b>Examiner</b> Jordan M. Schwartz	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24,29-34 and 43-56 is/are pending in the application.
- 4a) Of the above claim(s) 11-24,43,44,46-48,50 and 53-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-10,29-32,45,49,51 and 52 is/are rejected.
- 7) ☒ Claim(s) 4-7,33 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Foreign Reference</u> .                |

## **DETAILED ACTION**

### ***Restriction/Election of Species***

Applicant has amended the claims in the amendments received June 16, 2005 and August 2, 2005 changing the dependency of some of the claims and adding new claims prompting a new restriction requirement set forth below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, 29-34, 45-48, and 51-56. Claims 1-24 and 51-56 are drawn to a method of displaying performance information of athletic eyewear, classified in class 351, subclass 177. Claims 29-34 and 45 are being grouped together with Group I because they could be searched together with claims 1-10 and 51-52 without creating an undue burden on the examiner. Claim 46 is being grouped together with Group I because it could be searched together with claims 11-24 without creating an undue burden on the examiner. Claims 47-48 are being grouped together with Group I because they could be searched together with claims 53-56 without creating an undue burden on the examiner.
- II. Claims 43-44 and 50. Claims 43-44 are drawn to athletic eyewear, classified in class 351, subclass 159. Claim 50 is being grouped together with Group II because it could be searched together with claims 43-44 without creating an undue burden on the examiner.

The inventions are distinct, each from the other because of the following reasons:

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Inventions in Group II and Group I are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as in a process in which the display is cemented to the lens i.e. any process of using the athletic eyewear that does not required embedding the display in the lens or attaching the display to the lens with translucent tape or that does not require directing light into a light pipe associated with each segment of a display to be lit.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention. Group I contains claims directed to the following patentably distinct species. Group Ia, claims 1-10, 29-34, 45, 51-52, directed to a species of method of displaying information in which a display is embedded within a lens and activated by a source outside of the lens; Group Ib, claims 11-24 and 46, directed to a species of method of displaying information in which a display is attached

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to a lens on translucent tape; Group Ic, claims 47-48 and 53-56, directed to a species of method of displaying information in which a display is formed from a plurality of light pipes.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 49 is generic to Group I.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

During a telephone conversation with Thomas F. Brennan on September 13, 2005 a provisional election was made without traverse to prosecute the invention of Group Ia, claims 1-10, 29-34, 45, and 51-52 (and generic claim 49). Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-24, 43-44, 46-48, 50, 53-56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 29-30, 45, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 94/09398 (herein referred to as "WO'398").

WO'398 reads on these claims by disclosing the limitations therein including the following: a method of displaying information on eyewear (abstract, Figure 1); the information as "performance information" (page 4, line 17 to page 5, line 19 such as "a stop watch to show elapsed time"); comprising forming a lens wherein forming includes embedding a display in the lens (abstract, page 8, lines 3-11 re the display embedded in the lens); mounting the lens in the eyewear (Figure 1); activating the display from a source outside the lens (Figure 1, page 4, lines 25-31 re button batteries or solar panels on the frame); the lens mounted in the display such that it is viewable by a user wearing the eyewear (Figure 1); the display controller driving the display as a function of the information to be displayed (page 4, line 17 to page 5, line 19, page 7, lines 5-35); and the display as a liquid crystal display (page 2, first full paragraph). The eyewear of WO'398 could inherently be considered as "athletic" eyewear since it is being disclosed as providing on the display a stop watch for elapsed time (page 4, line 17 to page 5, line 19). Regardless, the claimed "athletic eyewear" goes to the intended use of the eyewear. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 8-10, and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO'398 in view of Gotah et al patent number 6,705,725.

WO'398 discloses as is set forth above including embedding the display within the optical material of the lens and that the embedded display can include light pipes (page 8, lines 3-11). The display and/or light pipes would inherently have to be suspended in the optical material prior to hardening in order for the display and/or light pipes to be located within the optical material of the lens. WO'398 discloses as is set forth above but does not specifically disclose the optical material of the lens as a resin formed by molding. Gotah teaches that eyeglass lenses can be formed by molding resin material for the purpose of providing an eyeglass lens of improved surface accuracy and optical properties (column 1, lines 13-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the eyeglass lens of WO'398 as formed by molding a resin material since Gotah teaches that eyeglass lenses can be formed by molding resin material for the purpose of providing an eyeglass lens of improved surface accuracy and optical properties.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO'398 in view of Carkner publication number 2004/0125348.

WO'398 discloses as is set forth above including disclosing the display as a liquid crystal display (page 2, line 5) but does not specifically disclose the display as a suspended particle device. Carkner teaches that an optical device incorporating a display can use either a liquid crystal display or a suspended particle display for the



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purpose of providing improved display imaging (paragraphs 0002-0005 and claim 18).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the display of WO'398 as a suspended particle display since Carkner teaches that an optical device incorporating a display can use either a liquid crystal display or a suspended particle display for the purpose of providing improved display imaging.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO'398 in view of Jacobson publication number 2004/0054031.

WO'398 discloses as is set forth above including disclosing the display as a liquid crystal display (page 2, line 5) but does not specifically disclose the display as an electrochromatic film. Jacobson teaches that an optical device incorporating a display can use either a liquid crystal display or an electrochromatic film for the purpose of providing improved display imaging (paragraph 0004). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the display of WO'398 as an electrochromatic film since Jacobson teaches that an optical device incorporating a display can use either a liquid crystal display or an electrochromatic film for the purpose of providing improved display imaging.

#### ***Prior Art Citations***

August, Schwartz, Cohen, Ladin, Wooten, Spitzer, and Rust et al are being cited herein to show eyewear that would have read on or made obvious a number of the above rejected claims, however, such rejections would have been repetitive.

#### ***Allowable Subject Matter***

Claims 4-7 and 33-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claims 4-7, none of the prior art either alone or in combination, disclose or teach of the claimed method of displaying performance information on athletic eyewear specifically including, as the distinguishing feature in combination with the other limitations, the claimed display as a segment display and wherein activating includes directing light into a light pipe associated with each segment to be lit. Specifically, with reference to claims 33-34, none of the prior art either alone or in combination, disclose or teach of the claimed athletic eyewear specifically including, as the distinguishing feature in combination with the other limitations, the claimed display formed from a plurality of light pipes wherein an end of each light pipe is attached to a shutter.

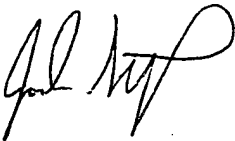
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:30 to 4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
September 23, 2005